

REMARKS

The present amendment is in response to the Office Action where the Examiner has rejected claims 1-12. By the present amendment, claims 1-12 are amended with claim 4, formerly an independent claim, amended to depend on claim 1. Claims 2, 5, 7, 8, and 12 are amended to correct antecedent basis errors, only. Claims 1, 3, 4, 6, 9, 10 and 11 are amended to clarify the invention, only. Thus applicant asserts that original claims 1-12 are patentable over the cited prior art, and the amendments are not made for the purpose of overcoming the cited prior art. In addition, claims 13-15 dependent on claim 12 and independent claim 16 and dependent claims 17-20 are newly added. Accordingly, claims 1-20 are pending in the present application with a total of six independent claims. Reconsideration and allowance of the pending claims in view of the amendments and the following remarks are respectfully requested.

A. Objection to the Specification

Applicant amends two paragraphs in the specification in accordance with the Examiner's Paragraph 2 of the Detailed Action.

B. Rejection of Claims 1, 2, 4, 7, 11, 12 under 35 U.S.C. §102(b)

The Examiner rejects independent claims 1, 4, 7, 11 and 12, and dependent claim 2, under 35 U.S.C. 102(b) as being anticipated by the Kaplan patent (U.S. Patent No. 5,884,193). Applicant respectfully disagrees. However, in order to expedite the prosecution of the present application, Applicant amends independent claims 1, 7, 11 and 12, and amends independent claim 4 to depend on claim 1. Applicant respectfully traverses the Examiner's rejections as discussed below.

To anticipate a claim under 35 U.S.C. sections 102(a), (b), or (e), the reference must teach every element of the claim. (See MPEP 2131.) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (Emphasis added) (Verdegaal

Bros. v. Union Oil Co. of California; see also MPEP 2131.) "The identical invention must be shown in as complete detail as is contained in the ... claim." (Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); see also MPEP 2131) Further any claim depending from base claims not anticipated or made obvious by the prior art also are not anticipated or made obvious by the prior art since the dependent claims comprise all of the elements of the base claims.

Applicant asserts that the Kaplan patent does not teach every element of independent claims 1, 7, 11 and 12, and thus, these independent claims, and the claims dependent thereupon, are patentable over the Kaplan patent as discussed below.

The Kaplan Patent (U.S. 5,884,193). The Kaplan patent teaches using a state machine-type process to analyze the digits entered by the user, and sets and enables signals accordingly. (See Kaplan, Col. 4, line 5-10.) Figure 2 of Kaplan illustrates the state machine flow diagram. As the user enters digits, the state machine determines whether the call is local, U.S. long distance, or international. The result is then checked against the call restriction table (See Kaplan, Fig. 4a) provided by a service provider. Note that the call restriction table distinguishes local, U.S. long distance, and International. Other flags may be used for special services/features, or for dialing within a specific country. After the result is checked, a restriction flag is set. (See Kaplan, Fig. 5a.) If the restriction flag is set, the entered telephone number is compared against stored "override numbers". If the entered number appears in the override numbers list, then the call is processed. Otherwise, the call is terminated. Similarly, if the restriction flag is not set, the entered telephone number is compared against stored "restriction numbers". (See Kaplan, Fig. 5b.) If the entered number appears in the restriction number list, the call is terminated. Otherwise, the call is processed. The Examiner should note that the Kaplan system 100 includes this "override data storage area 128 containing one or more user selected destination telephone numbers." (See Kaplan,

Col. 5, lines 5-23.) "The system 100 also includes a restricted number storage area 130 to store user-selectable destination telephone number that are restricted." (Id.)

Thus, Kaplan employs a state machine type process to an entered telephone number to look up restrictions in a call restriction definition table. A restriction flag is set accordingly. The entered number is then compared to specific (complete) stored numbers to determine whether to override the restriction flag. *In contrast to the present invention, Kaplan does not teach storing a plurality of area codes and/or numbers within area codes, that is, prefixes, for comparison against the corresponding portions of an inputted number.* Thus, since the Kaplan patent does not teach each and every element of the independent pending claims, as discussed further below, Applicant respectfully requests that the Examiner issue a notice of allowance for all of the pending independent claims, and the remaining claims dependent thereupon.

1. Independent claim 1, and dependent claim 2

The Examiner rejects claim 1 under 35 U.S.C. §102(b). Applicant asserts that independent claim 1 is not anticipated by Kaplan under 35 U.S.C. §102(b) since Kaplan fails to teach or suggest each and every element of independent claim 1. Specifically, claim 1 comprises, among other things, storing a plurality of geographic characteristics for comparison with an inputted phone number. Kaplan does not teach storing a plurality of geographic characteristics as asserted by the Examiner in his rejection on Page 3 of the Office Action. Rather Kaplan utilizes a state machine to determine whether a call is international, long distance, or local. Kaplan does use a comparison for a final check, but this comparison is against specific complete phone numbers. In contrast the present invention seeks to allow or restrict a number based on an immediate comparison with a portion of an inputted number, namely, the area code, and/or the prefix of the number, and not with specific entire phone numbers. Thus, Applicant traverses the Examiner's assertion on page 4 of the Office Action that Kaplan reads directly on "comparing the determined geographic characteristic of the inputted

phone number with each of the stored plurality of geographic characteristics." Since Kaplan does not teach each and every element of claim 1, the Kaplan patent does not anticipate the present invention under 35 U.S.C. §102(b).

Dependent claim 2 is rejected under 35 U.S.C. §102(b). Applicant asserts that dependent claim 2 is not anticipated by Kaplan under 35 U.S.C. §102(b). Specifically, claim 2 adds limitations of not placing a phone call based upon comparisons of the inputted number with the stored plurality of geographic characteristics. Kaplan does not store a plurality of geographic characteristics for comparison with the inputted number. Instead, Kaplan compares an entire inputted number with specific complete numbers stored in an override memory storage area. Thus, whereas Kaplan restricts or allows calls to specific recipients, the present invention restricts or allows call to unspecified numbers within area codes or sets of numbers within area codes. Thus, Kaplan does not teach each and every element of dependent claim 2, and Applicant respectfully requests the Examiner to issue a notice of allowance for these claims.

2. Independent claim 7

The Examiner rejects claim 7 under 35 U.S.C. §102(b). Applicant asserts that independent claim 7 is not anticipated by Kaplan under 35 U.S.C. §102(b) since Kaplan fails to teach or suggest each and every element of independent claim 7. Specifically, claim 7 claims, *inter alia*, storing a plurality of authorized area codes, determining a particular area code of the inputted phone number, and placing a phone call if the particular area code matches any of the stored authorized area codes. Kaplan neither teaches nor suggests the storing of area codes and placing a phone call based upon a match between an inputted area code and a stored area code.

In the Office Action on page 6, regarding claim 7, the Examiner asserts that Kaplan's method of storing a plurality of phone numbers in an override number storage area anticipates Applicant's invention. Applicant respectfully disagrees. Kaplan's method restricts specific phone numbers. This method would be quite cumbersome if all specific phone numbers to a particular area code or numbers within area codes

where to be restricted as the carrier would have to store thousands of number in the phone! Rather, the present invention stores area codes or sets of numbers (prefixes) within the area codes, only. The stored numbers are compared against the inputted area code or prefix, only, NOT the entire number.

The Examiner further cites a section of Kaplan where it "can be appreciated by those of ordinary skill in the art, a user will enter additional digits indicative of a country code, city code." (See Kaplan, column 5, lines 57-63.) This statement does not anticipate the storage of area codes or city codes as claimed in the present invention because Kaplan is referring to the act of a user entering these number, and not to these numbers being stored. In the Kaplan method, the entered number directs the flow of a state machine to determine whether a call is local, long distance, or international. Applicant traverses the Examiner's statement that a user's entering of these additional digits "reads on taking a phone number and determining a particular area code of the inputted phone number." The state machine of Kaplan does not determine an area code, rather it determines whether a call is local, long distance, or international. Since Kaplan does not teach or suggest each and every element of claim 7, Applicant respectfully requests the Examiner to issue a notice of allowance for this claim.

3. Independent claims 11 and 12

The Examiner utilizes similar arguments in his rejection of independent claims 11 and 12 under 35 U.S.C. §102(b). Specifically, the Examiner asserts that Kaplan's statement that "[a]s can be appreciated by those of ordinary skill in the art, a user will enter additional digits indicative of a country code, city code" reads directly upon the claim of "means for storing a plurality of geographic characteristics in a wireless communications device." (See the Office Action, page 7.) Applicant respectfully asserts that the Examiner's analysis relies upon impermissible hindsight. Specifically, there support is no support in the disclosures of Kaplan to modify the Kaplan device as suggested by the Examiner. Instead, Kaplan teaches utilizing the inputted phone number to direct a state machine to set an appropriate flag, after which the entire

inputted phone number is compared against entire specific phone numbers in an override storage area, as discussed above.

It is only with resort to the present applicant's disclosure that such a suggestion can be derived, which is well-established impermissible hindsight reconstruction: "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of hindsight syndrome where that which only the inventor taught is used against its teacher" (W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added). For all the foregoing, the Kaplan reference cannot result in the device specified by claims 11 and 12. Accordingly, Applicant respectfully requests that the Examiner issue a notice of allowance for independent claims 11 and 12.

C. Rejection of Claims 3, 5, 6, 8-10 Under under 35 U.S.C. §103(a).

The Examiner rejects dependent claims 3, 5, 6, 8-10 under 35 U.S.C. §103(a) as being unpatentable over Kaplan in view of Stephens (U.S. Patent No. 5,995,823). Applicant asserts that claims 3, 5, 6, 8-10 are dependent upon patentable independent claims as discussed above, and therefore are patentable. However, for completeness, Applicant respectfully traverses the Examiner's rejections, and submits that the independent claims are patentably distinguishable over the cited references, considered singly or in combination, as discussed below. That is, the independent claims are patentably distinguishable over the Kaplan patent, and, as such, the claims depending therefrom are, *a fortiori*, also patentably distinguishable over the Kaplan patent. Furthermore, the disclosure of the Stephens patent fails to cure the basic deficiencies of the Kaplan patent, and as such, the combined references of Kaplan and Stephens cannot result in the device specified by the claims rejected under 35 U.S.C. §103(a). Accordingly, claims 3, 5, 6, and 8-10 should be allowed.

An invention is unpatentable under 35 U.S.C. §103(a) if the differences between

it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

With respect to the first *prima facie* requirement, there is no motivation or suggestion to combine the Kaplan and the Stephens references in such a manner as to make the claimed invention obvious. Neither has it been demonstrated that the modification of the cited reference points to the reasonable expectation of success in the present invention, which is the second requirement of the obviousness analysis. With respect to the third requirement to support a *prima facie* case of obviousness, the two references do not teach all the limitations of the claims as discussed below.

The Stephens Patent (U.S. 5,995,823). The Stephens patent, as indicated in the title, provides a system for imposing toll restrictions based upon the geographic location of, for example, a cell phone. However, a "geographic location" of the Stephens patent is defined differently from that defined in the present invention. Specifically, a geographic location in the Stephens patent is defined as a cell of a cellular telephone system, wherein each geographic area has its own base station 36 and a single controller (not shown) interconnected with a public telephone network. (See Stephens,

Col. 6, lines 5-12, and Figure 3.) The Stephens patent teaches that geographic location of the cellular phone can be determine by a number of methods as discussed in Col. 7, lines 39-61. The Examiner will note that the "MSC 78 calculates the geographic location of the originator (caller) based on the geographic location of cellular telephone 72." (See Stephens, Col. 12, lines 12-14.) "[S]ervice is provided via the cellular telephone network, which can be broken down into two parts: subscription and geographic location screening." "Geographic location screening includes geographic location determination on origination with a determination of appropriate action to take for a given cellular telephone call." (See Stephens, Col. 12, lines 39-45, and Figure 5.) "Service node 84 coupled to HLR 86 and MSC-s 90, determines whether or not to allow the call to continue." (Stephens, Col. 13, lines 2-5.) *Thus, in contrast to the present invention, the geographic location of the cellular phone and whether a call is allowed is determined outside of the cellular phone.*

The Stephens patent does not teach each and every element of the independent pending claims, and does not cure the deficiencies of the Kaplan Patent, namely, the storing of geographic characteristics in the phone and comparing parts of an inputted number with the stored geographic locations as discussed further below. Thus, Applicant respectfully requests that the Examiner issue a notice of allowance for all of the pending independent claims, and the remaining claims dependent thereupon.

1. Dependent claims 3-6

Dependent claims 3 and 6 are dependent upon an allowable base claim 1, and thus are patentable. However for completeness, Applicant presents the following support that Claims 3 and 6 are not anticipated by Kaplan and are patentable over Kaplan in view of Stephens. Specifically, claims 3 and 6 are amended to specify that a GPS function inside of the phone is utilized to determine a position location, which is then utilized to authorize the placing of a phone call. The Examiner asserts, on Page 9 of the Office Action, that the determination of position location is well known in the art

as taught by Stephens, and it would have been obvious to one skilled in the art to modify Kaplan with the step of determining location to arrive at claim 3. Applicant respectfully disagrees with the Examiner. In fact, Stephens teaches away from the present invention such that position location of the cellular phone is determined outside of the phone. (See Stephens, Col. 12, lines 39-45, Figure 5, Col. 13, lines 2-5.) Neither Kaplan nor Stephens teach or suggest the use of a GPS function inside of a phone for restricting or allowing the placement of calls. Thus, Applicant respectfully requests that the Examiner issue a notice of allowance for dependent claims 3 and 6.

Claim 4 has been amended from an independent claim to a claim dependent on claim 1. As such, Applicant asserts that dependent claims 4 and 5 are not anticipated by Kaplan under 35 U.S.C. §103(a), and Stephens fails to cure the deficiencies of Kaplan. Specifically, claims 4 and 5 add limitations of placing/not placing a phone call based upon comparisons of the inputted number with the stored plurality of geographic characteristics. Kaplan does not store a plurality of geographic characteristics for comparison with the inputted number. Instead, Kaplan compares an entire inputted number with specific complete numbers stored in an override memory storage area. Thus, whereas Kaplan restricts or allows calls to specific recipients, the present invention restricts or allows call to unspecified numbers within area codes or sets of numbers within area codes. Thus, Kaplan does not teach each and every element of dependent claims 4 and 5. Further, call restriction of Stephens is based upon a decision made outside of the phone, and thus fails to cure the deficiencies of storage of geographic characteristic that is not found in Kaplan. Thus, Applicant respectfully requests the Examiner to issue a notice of allowance for these claims.

2. Dependent claims 8-10

Dependent claims 8, 9 and 10 are rejected as unpatentable over Kaplan in view of Stephens under 35 U.S.C. §103(a). Applicant asserts that Claims 8, 9 and 10 are dependent upon a patentable claim 7, and thus, are patentable. For completeness, however, Applicant presents the following supporting assertions. Similar to the

argument presented above with regards to claims 1, 2 and 6, Applicant asserts that claims 8, 9 and 10 are neither taught nor suggested by Kaplan. Specifically, a phone call is not placed in the claimed invention when an inputted area code does not match any of the plurality of stored authorized area codes. As discussed above, Kaplan does not teach storing a plurality of area codes. Rather Kaplan teaches storing specific entire telephone numbers in an override data storage area. That is, after Kaplan's state machine determines whether a call is local, long distance or international, the entire inputted phone number is compared against entire numbers in the override data storage area. In contrast, Applicant stores area codes and/or sets of numbers within area codes (prefixes) for comparison against only a portion of an inputted number. Further, Stephens fails to teach the deficiencies of the Kaplan patent. Stephens restricts a call based upon the physical location of the phone as determined by a source outside of the phone. In contrast, the present invention restricts a call based upon the number being called as determined by geographic characteristics stored inside of the phone. Since dependent claims 8, 9 and 10 are patentable over Kaplan in view of Stephens, Applicant respectfully requests that the Examiner issue a notice of allowance for claims 8-10.

D. Conclusion

Applicant asserts that claims 1-12 are neither anticipated by Kaplan under 35 U.S.C. 102(b) nor unpatentable over Kaplan in view of Stephens under 35 U.S.C. 103(a) as discussed above. The newly added claims 13-20 are also patentable over the cited prior art for the reasons discussed above with regards to claims 1-12. Thus, Applicant respectfully requests that the Examiner issue a notice of allowance for all of the pending claims 1-20.

Should the Examiner believe that prosecution of this application might be expedited by further discussion of the issues, he is invited to telephone the attorney for Applicant at the telephone number listed below.

Respectfully submitted,

By: 
Kathleen L. Connell
Attorney for Applicant
Registration No. 45,344

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KYOCERA WIRELESS CORPORATION
10300 Campus Point Drive
San Diego, California 92121

Telephone: (858) 882-2169
Facsimile: (619) 882-3650

Attorney Docket No.: UTL 00013

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